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TRADEMARK

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Application of:

Mizuno USA, Inc.

Serial No.:

77/272155

Filed:

September 5, 2007

Mark:

COMFORTFIT in International Class 28

NOTICE OF APPEAL

Applicant, Mizuno USA, Inc. (the "Applicant") hereby appeals to the Trademark Trial and Appeal Board (the "Board") from the final decision of the U.S. Patent and Trademark Office (the "PTO") dated June 9, 2008. The appeal fee of \$100.00 is submitted herewith. Applicant has simultaneously filed a Response to Office Action and Request for Reconsideration with the PTO. Pursuant to TMBP § 1204, TMEP § 715.04, and the policies of the Board, Applicant respectfully requests that the Board suspend action on this Appeal and remand the subject Application to the PTO for consideration of the Response to Office Action and Request for Reconsideration.

Applicant further requests that the Board suspend the time allowed by Applicant to file its appeal brief pending the PTO's decision regarding the Response to Office Action and Request for Reconsideration and reset such time in the event this Appeal continues following consideration by the PTO. Should the Board have any questions, please contact the undersigned at (404) 885-3380.

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Respectfully submitted,

TROUTMAN SANDERS LLEP

Bv

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12-10-2008

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE TRADEMARK EXAMINING OPERATION

In re Application of:

Mizuno USA, Inc.

Mark:

COMFORTFIT in International Class 28

LAW OFFICE 114

Serial No.:

77/272155

Filed:

September 5, 2007

RESPONSE TO OFFICE ACTION and REQUEST FOR RECONSIDERATION

Commissioner for Trademarks P.O. Box 1451 Alexandria, Virginia 22313-1451

Attention:

Mark Rademacher, Esq.

Trademark Examining Attorney

Law Office 114

Honorable Commissioner:

This Response to Office Action and Request for Reconsideration is submitted after issuance of the Final Office Action by the U.S. Patent and Trademark Office (the "PTO") dated June 9, 2008.

CERTIFICATE OF MAILING

Date of Deposit: December 8, 2008

I hereby certify that this Response to Office Action and Request for Reconsideration and accompanying exhibits are being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451 Attention: Mark Rademacher, Esq., Trademark Examining Attorney, Law Office 114.

F. RICHARD RIMER, JR., ESO.

Qate of Signature: December 8, 2008

I. INTRODUCTION

The PTO has made final its refusal to register Application Serial No. 77/272155 for the mark "COMFORTFIT" ("Applicant's Mark" or "Mark") under Trademark Act Section 2(e)(1), 15 U.S.C. § 1052(e)(1), based on a claim that the Mark is descriptive of the underlying goods. The Applicant respectfully requests that the PTO reconsider the arguments raised in the Applicant's previously submitted Office Action Response with respect to: (1) the suggestiveness of the Applicant's Mark, and (2) the PTO's prior practice concerning trademarks that include the words "comfort" and "fit" and that identify various types of sporting goods. The Applicant also respectfully requests that the PTO consider the additional arguments presented below. Such action is considered a proper response to the PTO's Final Office Action. TMEP § 715.02.

II. <u>LEGAL ANALYSIS</u>

In the Final Office Action, the PTO states that: (1) "Applicant is attempting to register the mark COMFORTFIT for golf gloves, baseball and softball gloves, and baseball and softball bating (sic) gloves," (2) "the word comfort immediately informs consumers that the gloves provide a feeling of physical well being – i.e., are comfortable," and (3) "[t]he word "fit" immediately informs consumers that the gloves are the right size or shape for the consumer." However, the Applicant respectfully submits that its Mark is not descriptive of the underlying goods.

As the PTO is aware, a mark comprising a combination of merely descriptive components is registrable if the combination of the terms creates a unitary mark with a unique, non-descriptive meaning. TMEP § 1209.03(d). Factors the PTO must consider in determining whether matter is part of a single or unitary mark include: whether the matter is physically connected; the relative location of the respective elements; and the meaning of the terminology as used on or in connection with the goods. TMEP § 1213.05. Section 1213.05 of the TMEP

further explains that "[i]f the matter that comprises the mark or relevant portion of the mark is unitary, no disclaimer of an element, whether descriptive, generic or otherwise, is required." Finally, Section 1213.05(a) *et. seq.* of the TMEP provides examples of unitary marks including compound word marks, telescoped words, double entendre, and sound patterns.

Applicant's combination of the terms "comfort" and "fit" into a unitary component, namely, COMFORTFIT, creates a physical connection and a relative location that would tend to favor a finding of a unitary mark. Further, this term is unique. As evidence of this, Applicant attaches hereto as *Exhibit A*, a print out from a search of the Lexis database confirming no use of the mark "COMFORTFIT" as a descriptive term. Further, the combination of the terms "comfort" and "fit" creates a unique and alliterative sound pattern with the two consecutive ending syllables beginning with an "f." Finally, the combination of the terms "comfort" and "fit" creates the opportunity for the ear to hear different words, such as "come for fit," thus creating the opportunity for a double entendre.

A "mark is unitary if the whole is something more than the sum of its parts." TMEP § 1213.05. By definition, all compound word marks are considered unitary, "and a disclaimer of a component will not be required *unless* the mark is appropriately presented in the application in a typed drawing as two or more separate words." TMEP § 1213.05(a). Because Applicant's use of COMFORTFIT in Applicant's Mark is a compound word, and is not presented as two separate words, the Applicant respectfully submits that it is therefore unitary and a disclaimer is unnecessary.

For the foregoing reasons, because Applicant's Mark is unitary and therefore registrable. However, to the extent that there is any doubt, it should be resolved in Applicant's favor. It is well settled that any doubt as to descriptiveness should be resolved in favor of the applicant. *In re Noble Co.*, 225 U.S.P.Q. 749 (T.T.A.B. 1985); *In re American Hospital Supply Corp.*, 219

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U.S.P.Q. 949 (T.T.A.B. 1983); In re Micro Instruments Corp., 222 U.S.P.Q. 252 (T.T.A.B. 1984).

III. <u>CONCLUSION</u>

Having responded to all of the outstanding issues raised in the Final Office Action, the Applicant respectfully requests that the PTO reconsider and approve its application for publication and registration on the Principal Register of the PTO.

Should the PTO have any questions, please contact the undersigned at (404) 885-3697.

Respectfully submitted,

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Exhibit A

